



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/523,583 | 03/10/2000 | Youji Kawamoto | 7217/61041 | 4985 |

7590 08/07/2003

Jay H Maioli
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

WANG, LIANG CHE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2155

DATE MAILED: 08/07/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,583

Applicant(s)

KAWAMOTO ET AL.

Examiner

Liang-che Alex Wang

Art Unit

2155

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-10, 13-17 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7-8, 13, 15, 17 are rejected under 35 U.S.C. 103(a) as being being unpatentable over Lee et al, US Patent Number 6,161,008, hereinafter Lee, In views of Floden et al., US Patent Number 6,230,002 B1, hereinafter Floden.
4. Referring to claim 1, Lee has disclosed a network system comprising:
 - a terminal device (see figure 1, item 120, 125, 132, 134, 140, 142) ;
 - a network server (see figure 1 item 150 and figure 4) connected to said terminal device via prescribed communication means (Col 2 lines 45-55), wherein a user of the network system and said terminal device to be used by the user are recorded in said network server (Col 2 lines 23-45, figure 4 and Col 11 lines 54-64) and said network server converts information to be transmitted to said terminal device used by the user into conformed information conformed to said terminal device used by the user, and transmits the conformed information to said terminal device (Col 11 lines 12-64.)

However, Lee has not taught wherein the terminal device include a slot for inserting and ejecting a memory device that stores information for user authentication; and wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

However, Floden has taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server (abstract, Col 1 lines 18-29, Col 2 lines 4-12, Col 2 line 64- Col 3 line 5, in the GSM system that authentication information is stored in the SIM card and when the device is turned on, the system would detect if the device has a SIM card with authentication information stored-in. This action of having the device turned on seeking for authentication is viewed as a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Lee such that to have terminal device including a slot for inserting and ejecting a memory device that stores information for user authentication; and wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server

by sending said information for user authentication and information about terminal specification to said network server.

A person with ordinary skill in the art would have been motivated to make the modification to Lee because SIM card is a well-known feature in the GSM system that provides ability for authentication information to be transferred from one device to another device. For example, if a user wishes to have her authentication information to be transferred from her old cellular phone to her new-fashioned cellular phone, all she needs to do is to place her SIM card from the old device to the new device without having to register with the service providers again. Although Lee fails to teach this improved feature of SIM card in his telecommunication system, however, Floden has taught the SIM card is defined in the Global System for Mobile Communication, therefore it would be obvious for a person with ordinary skill in the art to have Floden's GSM system to be placed on Lee's invention.

5. Referring to claim 2, Lee has further taught where in said network server forms a group of a plurality of users (Col 11 lines 1-10, and Figure 4) and transmits information from a user belonging to said group to a terminal device used by another user belonging to said group (devices listed in Figure 4 are well known communication devices that could send information to one another.)
6. Referring to claim 3, Lee has further taught the network system further comprising storage means (Col 15 lines 39-42), and wherein said terminal device includes interface means connected to said storage means (Col 15 lines 39-42, Col 6 lines 64-Col 7 lines 11, and figure 2) for storing information peculiar to said user and for storing specific

Art Unit: 2155

information on said group to which said users belongs in said storage means connected to said interface means (Col 15 lines 39-42, TID and PID are the information peculiar to the user Col 5 lines 28-32).

7. Referring to Claims 7, 8, 13, 15, 17. Claims 7, 8, 13, 15, 17 encompass the same scope of the invention as that of the Claims 1 and 2. Therefore, the Claims 7, 8, 13, 15, 17 are rejected for the same reason as the Claims 1 and 2.
8. Claims 4-6, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in views of Floden in further views of Boyle et al, US Patent Number 6,138,158, hereinafter Boyle.
9. Referring to Claim 4, Lee has disclosed a network system comprising:

a terminal device (see figure 1, item 120, 125, 132, 134, 140, 142)

a network server (see figure 1 item 150 and figure 4) connected to said terminal device via prescribed communication means (Col 2 lines 45-55), wherein a user of the network system and said terminal device to be used by the user are recorded in said network server (Col 2 lines 23-45, figure 4 and Col 11 lines 54-64)

However, Lee has not taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

However, Floden has taught wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about

Art Unit: 2155

terminal specification to said network server (abstract, Col 1 lines 18-29, Col 2 lines 4-12, Col 2 line 64- Col 3 line 5, in the GSM system that authentication information is stored in the SIM card and when the device is turned on, the system would detect if the device has a SIM card with authentication information stored-in. This action of having the device turned on seeking for authentication is viewed as a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Lee such that to have terminal device including wherein when said terminal device detects that said memory device is inserted into said slot, a request for authentication is sent to said network server by sending said information for user authentication and information about terminal specification to said network server.

A person with ordinary skill in the art would have been motivated to make the modification to Lee because SIM card is a well-known feature in the GSM system that provides ability for authentication information to be transferred from one device to another device. For example, if a user wishes to have her authentication information to be transferred from her old cellular phone to her new-fashioned cellular phone, all she needs to do is to place her SIM card from the old device to the new device without having to register with the service providers again. Although Lee fails to teach this improved feature of SIM card in his telecommunication system, however, Floden has taught the SIM card is defined in the Global System for Mobile Communication, therefore it would

be obvious for a person with ordinary skill in the art to have Floden's GSM system to be placed on Lee's invention.

Furthermore, Lee has not explicitly taught that when there is information to be transmitted to said terminal device used by the user, said network server notifies said terminal device used by the server of the presence of the information to be transmitted.

However, Boyle has taught when there is update of a server content, the mobile would be notified with a message to make users aware that there is information for user to receive so the user can make decision if they want to receive this information or not. (Boyle, Col 5 lines 24-36.)

A person with ordinary skill in the telecommunication art would know that users could send messages to each other in the same group, and the server would first receive the message from the send user then transmit the message to the requested receiving user. Applying the teaching of Boyle allows the user be aware of the message that they are going to receive, this would allows the users to make decision if they are going to receive this information or not.

Therefore, it would have been obvious for a person with ordinary skill in the art at the time the invention was made to have the server notifies the user when there is a message going to be sent as taught by Boyle. Because having notification before actually transmitting the data would make user be aware of the information that is going to be transmitted.

10. Referring to claim 5, Lee has further taught where the network server forms a group of plurality of terminal devices used by users (see Figure 4), and when there is information

send from a user belonging to said group, said network server notifies a terminal device used by another user belonging to said group of the presence of the above information (devices listed in Figure 4 are well known communication devices that could send information to one another and the notification is already taught by Boyle, as discuss in paragraph 15.)

11. Referring to claim 6, Lee has further taught the network system further comprising storage means (Col 15 lines 39-42), and wherein said terminal device includes interface means connected to said storage means (Col 15 lines 39-42, Col 6 lines 64-Col 7 lines 11, and figure 2) for storing information peculiar to said user and for storing specific information on said group to which said users belongs in said storage means connected to said interface means (Col 15 lines 39-42, TID and PID are the information peculiar to the user Col 5 lines 28-32).
12. Referring to Claims 9 and 10. Claims 9 and 10 encompass the same scope of the invention as that of the Claims 4 and 5. Therefore, the Claims 9 and 10 are rejected for the same reason as the Claims 4 and 5.
13. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in views of Floden in further views of Bodin, US Patent Number 6,387,027, hereinafter Bodin. Claims 14 and 16 recites the same limitation as in claim 1, except the limitation of erasing stored information on said server when the memory device is ejected from the slot. Lee as modified fails to teach this addition limitation. However, Bodin has taught a Mobile system that deletes the stored information when the SIM card (memory device) is removed from the terminal device (Col 2 lines 53-67.)

Art Unit: 2155

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Lee and Floden such that to have the limitation of erasing stored information on said server when the memory device is ejected from the slot.

A person with ordinary skill in the art would have been motivated to make the modification to Lee and Floden because having the method of erasing stored information would provide more free space on the server when the non-connected (SIM card removed) terminal device is not communicating with the server.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).
15. Minamida et al., US Patent Number 6,256,513, has taught the detection of service request upon insertion of SIM Card (Figure 15).
16. Johnston et al., US Patent Number 6,373,946, has taught a removable SIM card with authentication information (Figure 2, item 35).
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703)

Art Unit: 2155

305-3391. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain T can be reached on (703)308-6662. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.
19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Liang-che Alex Wang *lw*
August 4th, 2003

Hosain T. Alam
HOSAIN T. ALAM
PRIMARY EXAMINER